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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

TANAKA et al.

Art Unit: 3622

Application No. 09/209,454

Examiner: D. Lastra

Filed: December 11, 1998

For: SYSTEM FOR SELLING CONTACT
LENS

**TRANSMITTAL OF
APPELLANTS' APPEAL BRIEF**

U.S. Patent and Trademark Office
Randolph Building
401 Dulany Street, Customer Window, Mail Stop Appeal Brief - Patents
Alexandria, VA 22314

Dear Sir:

In accordance with 37 CFR 41.37, appellants hereby submit Appellants' Brief on Appeal.

The items checked below are appropriate:

1. Status of Appellants

This application is on behalf of ☒ other than a small entity or ☐ a small entity.

2. Fee for Filing Brief on Appeal

Pursuant to 37 CFR 41.20(2), the fee for filing the Brief on Appeal is for: ☒ other than a small entity or ☐ a small entity.

Brief Fee Due \$500.00

3. Oral Hearing

☐ Appellants request an oral hearing in accordance with 37 CFR 41.47.

A separate paper requesting oral hearing is attached.

4. Extension of Time

- ☐ Appellants petition for a one-month extension of time under 37 CFR 1.136, the fee for which is \$ 0.00.
- ☒ Appellants believe that no extension of time is required. However, this conditional petition is being made to provide for the possibility that appellants have inadvertently overlooked the need for a petition and fee for extension of time.

Extension fee due with this request: \$

5. Total Fee Due

The total fee due is:

| | |
|--------------------------|----------|
| Brief on Appeal Fee | \$500.00 |
| Request for Oral Hearing | \$ 0.00 |
| Extension Fee (if any) | \$ 0.00 |

Total Fee Due: \$500.00

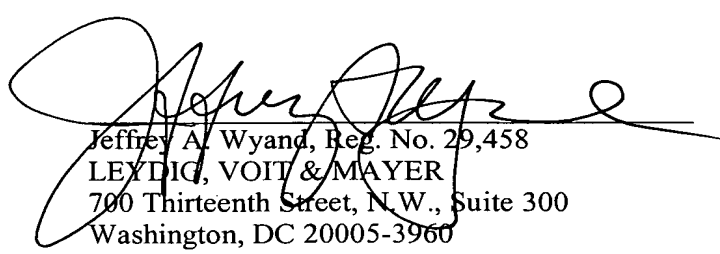
6. Fee Payment

- ☐ Attached is a check in the sum of \$
- ☒ Charge Account No. 12-1216 the sum of \$500.00. A duplicate of this transmittal is attached.

7. Fee Deficiency.

- ☒ If any additional fee is required in connection with this communication, charge Account No. 12-1216. A duplicate copy of this transmittal is attached.

Respectfully submitted,


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Date: March 14, 2005
JAW:ves



PATENT
Attorney Docket No. 188125

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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APPELLANTS' APPEAL BRIEF

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Dear Sir:

Further to the Notice of Appeal filed January 14, 2005, Appellants now submit their Brief.

Real Party In Interest

The patent application that is the subject of this appeal is assigned to Menicon Co., Ltd. of Nagoya, Japan.

Related Appeals and Interferences

There are no other prior or pending appeals, interferences, or judicial proceedings which are related to, directly affect, or may be directly affected by or have a bearing on the decision in this appeal.

Status of Claims

This patent application was filed with claims 1-14. Through the lengthy prosecution, all of the original claims were cancelled and claims 15-22 were added. Added claims 15 and 16 were cancelled leaving claims 17-22 pending. Those pending claims appear in the Claims Appendix. No claim is allowed and the final rejection of all claims is appealed.

Status of Amendments

No amendment or other response was filed in reply to the Office Action mailed October 21, 2004. In view of the lengthy prosecution of the patent application a Notice of Appeal was filed in lieu of an Amendment and/or arguments in response to the final rejection.

Summary of Claimed Subject Matter

Of claims 17-22, only claim 17 is an independent claim. The general subject matter of claim 17 concerns a method of selling contact lenses to a user and communications between contact lens prescribers, contact lens users, sometimes called contact lens customers, and contact lens suppliers and then selling agents that supply contact lenses fitting the prescription to the customer.

A number of embodiments of the invention are described in the patent application. Many of the embodiments have common elements, such as network communications between three groups. The following discussion, focusing on claim 17, pursuant to 37 CFR 41.37(c)(1)(v), as the only independent claim draws from common features of those embodiments and therefore identifies various elements referred to in the claimed method by multiple reference numbers and line numbers of the patent application that encompass the different embodiments.

In the background of the claimed method there is a communication network (1) providing communication between information processing apparatus in a second group of such apparatus located at contact lens prescribers, such as ophthalmologists, and a first group of information processing apparatus located at facilities of contact lens sellers. Examples of such communication arrangements are illustrated in Figures 1-4 of the patent application. According to the claimed method, information that pertains to a particular

contact lens customer and identifies that customer, including address and diagnostic data pertaining to that customer is transferred from a plurality of the second group information processing apparatus (4, 24), located at the facilities of contact lens prescribers to first group information processing apparatus (2, 22) located at facilities of contact lens sellers, through a communication network (1). With regard to the first embodiment of the patent application, this transfer of contact lens customer information is described at page 10, lines 14-19. A similar description appears at page 9, lines 2-20 of the patent application. The communication network and the exchange of information is likewise described for other embodiments of the patent application from page 15, line 27 through page 16, line 25.

At the contact lens seller, in the second step listed at claim 17, a registration number is assigned to the customer and that registration number is assigned in relation to other customer identification and diagnostic information that has been transferred to the contact lens seller from the contact lens prescribers. This step is described at page 11 in lines 2-7 of the patent application. As to the second described embodiment of the invention, this step is described from page 18, line 24 through page 19, line 5 of the patent application.

An important feature of the claimed method is provision of convenience for a contact lens user because contact lenses frequently need to be replaced. The typical lenses employed have an expected lifetime and are discarded and replaced at the expiration of that lifetime. Thus, in the third step of claim 17, the registration number assigned to the contact lens user and selling agent data for a selling agent of the contact lens seller that is closest in geographical relation to the customer, based on the customer address information is supplied to the customer through the communication network. As described at page 11 lines 8-12 of the patent application, this feature permits the contact lens customer to find and deal with the selling agent closest to the customer.

Based upon this exchange of information and the relationship between the contact lens customer and the selling agent identified, the contact lenses are delivered from the selling agent to the contact lens customer as described at page 12, lines 16-19 of the patent application. Further, delivery data is transferred from the selling agent to the contact lens seller through the communication network as shown in Figure 9 of the patent application, a master flowchart of the claimed process. The transfer of the delivery data is indicated in Figure 9 by the line connecting the "contact lens seller (head office)" to the box representing the "selling agent". The transfer of this information is also described in the patent application at page 11 in lines 8-14.

An important feature of the invention includes the use of a portable recording medium, such as an IC card represented in Figures 3 and 5 by elements 23 and 33. In the

method according to the invention, there is written, through the information processing apparatus of the contact lens prescriber and the information processing apparatus of the contact lens seller customer data, including diagnostic, i.e., prescription, information for the contact lenses that are prescribed for the customer having possession of the portable recording medium. See the patent application at page 16, lines 9-16. The employment of this portable medium, such as an IC card, provides an important advantage of the invention which permits the contact lens customer to choose any contact lens prescriber while remaining loyal to a particular lens seller. This feature is expressly stated in the sixth step of claim 17 and described at page 17, lines 8-26 of the patent application. In less formal words, the contact lens customer, with the IC card in hand, can consult any ophthalmologist who has the apparatus for reading information from the card necessary for providing services to the contact lens customer. Yet, the customer remains loyal to a particular contact lens supplier, who may sponsor the system according to the invention to develop customer loyalty.

As already described, an important feature of currently used contact lenses is their limited lifetime. In the step of the penultimate paragraph of claim 17, the method determines the time at which contact lenses should be exchanged, i.e., replaced, based upon their date of issuance or delivery and the characteristics of the contact lens. Of course, the first group of information processing apparatus located with the contact lens seller has the necessary information to determine this time, for example, by using the data that is recorded on the portable recording medium for the contact lenses that have previously been issued. This feature of calculating the exchange time for the lenses is described in the patent application at page 16, lines 14-25. The information concerning the exchange time is employed by giving notice to a contact lens customer of that time for the exchange, in advance of the exchange.

The dependent claims describe further features of the invention. For example, claim 18, as described in the patent application at page 13, lines 9-15, page 16, lines 21-23, and page 21, lines 5-19, uses the communication network to give notice to a customer that a lens exchange time is approaching for that particular contact lens customer. Again, the reminder inspires customer loyalty to the contact lens supplier as well as ensuring continued and repeated sales.

Besides the periodic necessity of replacing contact lenses due to the expiration of their lifetime, from time-to-time it is necessary to replace contact lenses on an irregular basis because of damage. The method according to dependent claim 19 provides for that exchange privilege as part of a contract with a monthly payment by a contact lens user. This

feature of the invention is described in the patent application at page 13, lines 16-26 and page 21 at lines 24-27.

The contact lens seller may increase the amount of sales by not restricting sales to contact lenses but also supplying contact lens care articles, such as cleaning agents that must be employed to maintain the contact lenses in a usable state. According to claim 20, using the communication network, the seller periodically offers for sale these care articles as described in the patent application at page 13, lines 5-8 and also at page 16, lines 21-23, and page 21, lines 5-19. Further, as described in claim 22, which depends from claim 20, these offerings of contact lens care articles may be timed based upon prior sales of similar articles in conjunction with the normal time for consumption of those articles. When that normal consumption period approaches, then the offering for sale is renewed, for example, on a periodic basis as described in claim 22 and at page 13, lines 5-8 of the patent application.

A further feature of the invention includes providing contracts for a minimum term of one year, committing a contact lens customer to using a particular contact lens seller in exchange for a monthly payment. This feature of dependent claim 21 is described in the patent application at page 22, lines 15-20.

Grounds of Rejection to be reviewed on Appeal

Are either of claims 17 and 19 obvious over a purported combination of Pauly et al. (U.S. Patent 4,958,280, hereinafter Pauly) in view of Fay (U.S. Patent 5,983,201) and further in view of Eberhardt (U.S. Patent 5,659,741)?¹

Argument

The invention as described in claim 17 includes a number of steps, including transferring specified information concerning a contact lens customer from a prescriber, for example, an ophthalmologist, who uses information processing apparatus that is part of a group of such apparatus connected through a network to a number of different such prescribers. The information is transferred within the network to which respective contact lens sellers and their agents may be connected. A single contact lens seller is

¹ Additional references were cited in rejecting dependent claims 18, 20, and 22. However, those references were relied upon solely as allegedly disclosing elements of dependent claims 18, 20, and 22. One of those patents, U.S. Patent 5,623,242 to Dawson was mentioned in the body of the Office Action mailed October 21, 2004 but has never been made of record by listing on a PTO-892 Form. Applicants rely upon the patentability of claim 17 as grounds for reversing the rejections of claims 18-20, and 22. Additionally, reliance is placed upon the patentability of claim 19 for the patentability of claim 21.

focused on in claim 17. That contact lens seller has an information processing apparatus connected to the network. In the claimed method, among other steps, there is issued to each contact lens customer a portable recording medium containing information relating to the contact lenses that are prescribed for that customer and to contact lenses that subsequently issued to that customer. As previously described, through using this portable recording medium a customer can change prescribers while maintaining contact with a particular lens seller, for example, through a selling agent who is close in geographical location to the contact lens user/customer.

While the Examiner repeatedly asserted that this important feature of the invention is absent from claim 17, attention is directed to the sixth paragraph of claim 17 (lines 21-26, claim 17 in the Claims Appendix) which describes this feature of the claimed method. As previously explained, and even acknowledged at page 8 of the Office Action mailed October 21, 2004, the portable recording medium belonging to a particular contact lens customer permits the contact lens customer to consult any prescriber, for example, any ophthalmologist, and to bring information concerning his prescription with him easily. This capacity avoids issues concerning a patient-physician relationship in which the contact lens customer is forced to continually consult the same prescriber. The loyalty established by the method described in claim 17 is between the contact lens user and the contact lens seller or selling agent representing the contact lens seller, not with the prescriber. This feature was not recognized in final rejection. At page 8, the Office Action of October 21, 2004 not only erroneously insisted on the absence from claim 17 of that feature but falsely asserted that the arguments on this point previously presented are opposite from the arguments most recently presented by the Applicants. Applicants have stated, consistently, that the patient-physician loyalty/dependency is reduced by the invention.

With regard to this important feature of the invention, Pauly provides a totally contrary feature that cannot establish obviousness of claim 17. Pauly is directed to a method of supplying disposable contact lenses, that is the subject of a prescription, to contact lens users. However, the entire thrust of Pauly is to supply those lenses through a prescriber, essentially chaining a contact lens uses to that prescriber rather than encouraging direct interaction between the contact lens user and a contact lens seller or his selling agent. Attention is directed to Pauly at column 2, lines 17-22.

“It is an associated object [of the invention] that such systems and methods promptly and accurately allow attending eye care professionals to maintain acclose [sic] doctor-patient relationship

and provide initial and ongoing prescription fulfillment with minimal intrusion into that relationship.”

Another important feature of the method of claim 17 is the delivery of contact lenses from a selling agent to a contact lens customer. That selling agent is identified by the contact lens seller participating in the system employing the claimed method as the agent nearest to the location of the particular contact lens customer. This step has not been shown to be present in Pauly because in Pauly the relationship is between the user and prescriber to the exclusion of the supplier/seller.

Even if Pauly stood for the propositions for which it was cited, Fay would not suggest a modification of Pauly to support the rejection. All parties acknowledged that Fay does not concern the dispensing or prescription of contact lenses. Rather, Fay concerns dispensing of eyeglass frames through a virtual optician. While, traditionally, eyeglass frames are purchased from an optician who concurrently supplies prescription lenses fitting the frames, the adoption of contact lenses eliminates the necessity of eyeglass frames or even consulting an optician. Rather, the prescription contact lenses come from a different source. Further, there are no medical implications in the selling of eyeglass frames. Instead it is the appearance of the frames on the wearer of eyeglasses that is the focal point of selling eyeglass frames. Acknowledging that fact, Fay describes a system in which an image of the face and head of an eyeglass wearer is captured so that the eyeglass wearer can view images of himself fitted with various eyeglass frames and decide which frames are most becoming. Fay offers a particular advantage because it can generate images of eyeglass frames produced by a wide variety of manufacturers, rather than a limited number of eyeglass frames from particular manufacturers that might be available at an actual, not virtual, optician.

In asserting that Fay is an appropriate reference for modifying Pauly, reliance was placed upon the passage at column 9, lines 4-8 of Fay allegedly describing viewing, selection, and purchase of products related to eyeglass frames. What that passage states is that the system can be used “to view, select and purchase other head related products, such as jewelry, cosmetics and hair products.” This specific description of items, omitted from the Office Action, shows that Fay has no relationship to any optical product beyond eyeglass frames.

Moreover, it is almost too fundamental to point out that one purpose of using contact lenses instead of eyeglasses is that the contact lenses do not significantly modify the wearer’s appearance. Therefore, a person obtaining contact lenses would have no reason to employ the system described by Fay to determine how his facial appearance

might change when using contact lenses. Stated otherwise, Fay provides no suggestion for modifying Pauly.

For both of the foregoing reasons, a person of skill in the art would not consult Fay to seek a modification of the system described in Pauly for distributing contact lenses. The conclusion drawn in the final rejection at pages 3 and 4 that Fay would suggest a modification of Pauly, that the selling agent in Pauly would be an optical retail store, and that the customer would visit the store to obtain contact lenses to save shipping and handling charges is clearly fabricated based upon knowledge of the invention. Using that knowledge of the invention, the disclosure of Fay has been contorted in ways that are not only outside the teaching of Fay, but outside the scope and content of Fay, in an attempt to suggest a modification of Pauly. On this ground alone, the rejection of claim 17 and all of the other pending claims cannot be sustained.

As acknowledged in the final rejection, neither Pauly nor Fay employs a portable memory medium, such as an IC card, that facilitates consultation of various prescribers by a contact lens user. Eberhardt was relied upon as allegedly disclosing such a recording medium that can be employed to store a medical history for a particular individual. However, even if the disclosure of Eberhardt is expanded so that medical history includes eye examinations and contact lens prescriptions, and assuming Eberhardt would suggest a modification of Pauly, the rejection of claim 17 still could not be sustained because, as described above, there is no basis for modifying Pauly with Fay, an essential element of the final rejection. Therefore, the rejection of claim 17 and its dependent claims 18-22 should be reversed.

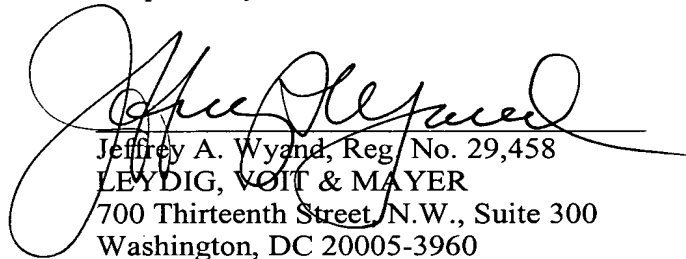
Claim 19 adds a further limitation to claim 17 regarding a program of offering replacement contact lenses to a customer at regular intervals when previously supplied contact lenses are no longer usable, provided the customer makes a monthly payment for the supplying of contact lenses on a regular basis. The rejection of claim 19 is erroneous because there is no factual basis for the rejection. The Office Action of October 21, 2004 acknowledges that the limitation of claim 19 is not described by Pauly and does not assert that the limitation can be found in either of Fay or Eberhardt. Rather, the claim has been dismissed as obvious for no particular reason. See the final rejection at page 5, lines 16-19. This kind of rejection, without proper support by a printed publication or a demonstration of common knowledge in the art violates the requirement of *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) that an examiner must provide a factual basis to support a rejection. Unsupported comments cannot establish *prima facie* obviousness so

that the rejection of claim 19, independent of the rejection of its parent claim 17, should also be reversed.

Conclusion

Because *prima facie* obviousness has not been established with regard to either of claims 17 and 19, the rejections of all of claims 17-22 should be reversed.

Respectfully submitted,



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Date: March 14, 2005
JAW:ves

Claims Appendix

17. A method of selling prescription contact lenses comprising:

transferring contact lens customer identification, address, and diagnostic data pertaining to a respective contact lens customer from a plurality of second group information processing apparatus located at respective facilities of contact lens prescribers, the plurality of second group information processing apparatus being connected through a communication network to a first group information processing apparatus located at a facility of a contact lens seller, to the first group information processing apparatus through the communication network;

assigning a registration number to the customer and storing the registration number assigned in relationship with the customer identification and diagnostic data transferred to the contact lens seller;

providing the registration number assigned and selling agent data for a selling agent closest in geographical relation to the customer based on the contact lens customer address data, from the contact lens seller to the contact lens customer, through the communication network;

delivering a contact lens from the selling agent to the contact lens customer;

transferring delivery data from the selling agent to the contact lens seller through the communication network;

writing, through both the first group information processing apparatus and the plurality of second group information processing apparatus, on respective portable recording media for each contact lens customer, data, including the corresponding registration number, and issuing the corresponding portable recording medium to the respective customer, so the contact lens customer can select any contact lens prescriber, and change between any contact lens prescriber, having access to one of the second group information processing apparatus and the communication network without changing the contact lens seller;

determining an exchange time for exchanging the contact lens, based upon date of issuance of the contact lens and characteristics of the contact lens, by the first group information processing apparatus of the contact lens seller, using data recorded on the portable recording medium of the corresponding contact lens customer to whom a contact lens has been issued by the contact lens seller through the selling agent; and

notifying a contact lens customer to whom a contact lens was issued of the exchange time.

18. The method of Claim 17, including delivering notification of an approaching deadline to replace the contact lens from the contact lens seller to the contact lens customer through the communication network.

19. The method of Claim 17, including offering new contact lenses to the contact lens customer in exchange for old contact lenses at irregular times, upon any of loss of transparency of the contact lenses, breakage of the contact lenses, and scratching or soiling of the contact lenses, and a monthly payment by the contact lens customer.

20. The method of Claim 17, including periodically offering for sale contact lens care articles by the contact lens seller to the customer through the communication network.

21. The method of Claim 19, including contracting for a one year term with the respective contact lens customer for supplying long-term-use contact lenses in exchange for the old contact lenses and the monthly payment.

22. The method of Claim 20, including periodically offering for sale the contact lens care articles based upon a consumption period of the contact lens care articles and date of most recent sale of the contact lens care articles to the respective contact lens customer transmitted from the first group information processing apparatus.

• In re Appln. of TANAKA et al.
Application No. 09/209,454

Evidence Appendix

No evidence was presented in the prosecution of the patent application.

In re Appln. of TANAKA et al.
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Related Proceedings Appendix

There are no related proceedings.